

INTERPRETATION OF 37 CFR §§ 11.7(d)(2) AND (d)(3)

This notice explains the interpretation of 37 CFR §§ 11.7(d)(2) and (d)(3) by the Director of Enrollment and Discipline (OED Director) and background information for that interpretation. These subsections concern the circumstances under which the Director may waive the registration examination for former employees of the United States Patent and Trademark Office (USPTO or Office). As this notice explains, the phrase “patent examining corps,” which appeared in the penultimate sentence of former 37 CFR § 10.7(b) and now appears in §§ 11.7(d)(2) and (d)(3), is as broadly interpreted now as it was in construing § 10.7(b).

In summary, § 11.7(d)(2) grandfathers the following employees who actively served four or more years as patent examiners as eligible for waiver of the registration examination: those who on July 26, 2004 staffed the Commissioner of Patents and the organizations reporting to the Commissioner, including the Deputy Commissioner of Patent Examination Policy, the Deputy Commissioner of Patent Operations (including Patent Examining Groups), or the Deputy Commissioner for Patent Resources and Planning; and those who on July 26, 2004 staffed External Affairs, Office of Enforcement, Office of International Relations, Office of Congressional Relations, Board of Patent Appeals and Interferences, or Office of Enrollment and Discipline. For employees having a quality performance element in their performance plan, the registration examination would be waived upon satisfying §§ 11.7(d)(2)(ii) and (iii). For employees lacking a quality performance element in their performance, the examination would be waived upon filing a request under 37 CFR § 11.5 for waiver of the requirements under §§ 11.7(d)(2)(ii) and (iii) and showing the waiver is necessary or justified. See the discussion in the last paragraph *infra* of how to justify the waiver under § 11.5.

Before July 26, 2004, the OED Director could waive the taking of the registration examination in the case of an individual who had actively served for at least four years in the patent examining corps of the Office. See 37 CFR § 10.7(b), penultimate sentence, and its predecessor rule, 37 CFR § 1.341(c). These rules were applied at the time the individual separated from the Office. The examination was not waived in the cases of former examiners who, upon separation from the Office, were rated unacceptable for quality performance elements.

As of July 26, 2004, the registration examination may be waived in the case of a former patent examiner meeting the scientific and technical training requirements if the individual demonstrates that he or she, *inter alia*, actively served for at least four years in the patent examining corps of the Office by July 26, 2004, and was serving in the corps at the time of separation from the Office. See 37 CFR § 11.7(d)(2). The qualifications for former examiners who qualified under the penultimate sentence of § 10.7(b) are grandfathered into the provisions of § 11.7(d)(2). Section 10.7(b) and its predecessor rules did not define the “examination corps.”

Many Office organizations have been created and staffed with employees who actively served as patent examiners for four or more years. At one time, all the organizations

reported to the Commissioner of Patents. With the passage of time, the Office was reorganized, and not all organizations continue to report to the Commissioner of Patents. Some employees who served four years as examiners and staffed the organizations were in organizations that no longer reported to the Commissioner of Patents. These former examiners separated from the Office while being a part of the staff of such organizations. The provisions of § 10.7(b) were applied to the former patent examiners whether or not the organization reported to the Commissioner of Patents. For example, the examination was waived in the case of patent classifiers in the Classification Operations and members of the Board of Patent Appeals and Interferences who had actively served as patent examiners for four or more years.

There is no intent in the provisions of 37 CFR § 11.7(d)(2) to change the eligibility for waiver of the examination for Office employees who had actively served at least four years in the patent examining corps on or before July 26, 2004. Accordingly, “patent examining corps” in § 11.7(d)(2) is construed to encompass the Commissioner of Patents and the organizations reporting to the Commissioner. This includes, for example, organizations reporting to the Deputy Commissioner of Patent Examination Policy, the Deputy Commissioner of Patent Operations (including Patent Examining Groups), and the Deputy Commissioner for Patent Resources and Planning.

Due to reorganization of the Office, some organizations no longer report to the Commissioner of Patents. The “patent examining corps” is also construed to include: External Affairs, Office of Enforcement, Office of International Relations, Office of Congressional Relations, Board of Patent Appeals and Interferences, and Office of Enrollment and Discipline. For the employees staffing these organizations on July 26, 2004 who had actively served four or more years as patent examiners prior to the same date, “patent examining corps” in § 11.7(d)(2) is also construed to include the foregoing organizations.

Section 11.7(d)(1), unlike § 11.7(d)(2), does not grandfather the registration examination waiver provisions of § 10.7(b) for former patent examiners who had not actively served four years in the patent examining corps by July 26, 2004. Therefore, “patent examining corps” in § 11.7(d)(1) does not address the employees addressed in § 11.7(d)(2). For § 11.7(d)(1), “patent examining corps” is the Commissioner of Patents and the organizations reporting to the Commissioner, but does not include such organizations as External Affairs, Office of Enforcement, Office of International Relations, Office of Congressional Relations, Board of Patent Appeals and Interferences, and Office of Enrollment and Discipline.

Under 37 CFR § 11.7(d)(3) the registration examination may be waived for certain former Office employees who were not serving in the patent examining corps upon their separation from the Office. The provisions of § 11.7(d)(3) do not impact current employees who are grandfathered former examiners under the provisions of § 11.7(d)(2). Thus, for example, a current member of the Board of Patent Appeals and Interferences who actively served as a patent examiner for four or more years is subject to the

grandfather provisions § 11.7(d)(2). Section 11.7(d)(3) applies *in futuro* to Office employees who are not grandfathered by § 11.7(d)(2).

A former employee seeking waiver of the examination under § 11.7(d)(3) must satisfy the scientific and technical training requirements, and must demonstrate possession of the necessary legal qualifications to render to patent applicants and others valuable service and assistance in the preparation and prosecution of their applications or other business before the Office. The former employee may do so by showing “(i) [h]e or she has exhibited comprehensive knowledge of patent law equivalent to that shown by passing the registration examination as a result of having been in a position of responsibility in the Office in which he or she: (A) Provided substantial guidance on patent examination policy, including the development of rule or procedure changes, patent examination guidelines, changes to the Manual of Patent Examining Procedure, or development of training or testing materials for the patent examining corps; or (B) Represented the Office in patent cases before Federal courts.”

Organizations that are normally not considered to be part of the patent examining corps, *e.g.*, organizations under General Counsel and Administrator of External Affairs, are staffed with some personnel who are grandfathered under § 11.7(d)(2), and with other personnel who are not grandfathered. Section 11.7(d)(3) will apply to employees in these organizations who are not grandfathered, but are first employed in these organizations on or after July 26, 2004. The non-grandfathered employees may or may not have served as patent examiners. Under § 11.7(d)(3) non-grandfathered employees in these organizations may seek waiver of the registration examination (not waiver of the scientific and technical training requirements). Section 11.7(d)(3)(i)(A) affords the non-grandfathered employees with a nonexclusive list of means to show that they provided substantial guidance on patent examination policy. Pursuant to the listed means, the non-grandfathered employee may show that he or she developed rule or procedural changes affecting patent examination, developed guidelines for the examination of patent applications, authorized and edited changes to the Manual of Patent Examining Procedure, or developed or vetted questions and other training materials for patent examiners. Additionally, these employees may show that they provided substantial guidance on patent examination policy in ways not listed in the rule. Thus, representing the Office in international relations and legislative affairs are understandably activities that can provide guidance on patent examination policy. Board of Patent Appeals and Interferences employees provide guidance in patent examination policy in a variety of their functions, including reviewing decisions of patent examiners, acting on petitions, evaluating whether Board decisions are to be made precedential, consulting on declaring interferences, as well as participating in examiner training, and developing or vetting questions and other training materials for patent examiners.

Waiver of the examination under § 10.7(b) was never automatic; it has always been discretionary. Former examiners who, upon separation from the Office, were rated unacceptable for quality performance elements were required to take the registration examination. Sections 11.7(d)(1), (2) and (3) continue to require quality performance. Under these sections the former employee must be rated at least fully successful in each

quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner in the Office, and not be under an oral or written warning regarding the quality performance elements at the time of separation.

For some employees, the applicable performance plan may not include a separate quality element. The employee may request waiver of the requirement under 37 CFR § 11.5 by making a showing that the waiver is necessary or justifiable. The employee may justify the waiver by demonstrating substantially equivalent ratings. For example, the employee would show that he or she was rated at least fully successful for the last two complete fiscal years in the Office and that there was no adverse information regarding the employee's competence to represent patent applicants at the time of separation from the Office.

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/s/
Harry I. Moatz
Director of Enrollment and Discipline